

### **REMARKS**

The claims have been amended in response to the outstanding rejections. Claim 1 has been limited to a method to treat pain, an indication that was already set forth in the claim, and is therefore supported. Claim 16 has been made independent and is also directed to a method to treat pain. Both claims 1 and 19 have been amended to correct an oversight wherein an inconsistency in the value of n was kindly noted by the Office. Thus, no new matter has been added and entry of the amendment is respectfully requested.

There is no remaining rejection over the art.

#### **The Rejection Under 35 U.S.C. § 112, Paragraph 1**

This was applied to claims 1-5, 7 and 9-16, all of them directed to methods of treatment. Applicants appreciate the acknowledgement that the specification is clearly enabling for the treatment of pain as the success of these compounds has been demonstrated in an animal model. Such a demonstration has been held adequate to support enablement, for example, in *In re Brana*, 51 F3d 1650, 34 USPQ2d 1436 (Fed. Cir. 1995). Accordingly, this basis for rejection may be withdrawn.

#### **The Rejections Under 35 U.S.C. § 112, Paragraph 2**

All claims were rejected because claims 1 and 19 had an inconsistency in the value of n. This has now been corrected.

The Office then objects that claims 16 and 19 name compounds that appear to have  $n = 0$ , a value that is no longer present in claims 1 and 19. Claim 16 has been amended so that it no longer depends on claim 1 and thus the five compounds noted by the Office, where indeed, n is 0, are

